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08/886,881

07/02/97

ECKSTEIN

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PA1220-C2

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IM62/0112

EXAMINER

TARAZANO, D

ART UNIT

PAPER NUMBER

1773

11

DATE MAILED:

01/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/886,881

Applicant(s)

Eckstein et al.

Examiner
D. Lawrence Tarazano

Group Art Unit
1773



☒ Responsive to communication(s) filed on Nov 1, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 7, 8, 10-16, 18, 35-37, 41-49, and 51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 7, 8, 10-16, 18, 35-37, 41-49, and 51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1773

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 15 and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants recite that they are making LDPE materials by single site catalysis. It is well accepted in the art that the term LDPE is a highly branched material made by a high pressure process. This clearly goes against the art of single site catalysis which produces materials having low or no branching (for example see Lai et al. 5,272,236 column 3, lines 47+). It is well accepted in the art that low density polyethylene and linear low density polyethylene have different structures. It appears that the applicants have made reference to the wrong material.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 1773

3. Claims 1-3, 7-8, 10-16, 18, 35-37, 41-49, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Lai et al. (5,272,236):

Lai et al. teaches films made from polymers produced using single site catalysts, see example 10 and the abstract.

The materials are copolymers of butene, hexene and octene (column 3, lines 41+).

They can be formed into blends (column 14, lines 31+).

4. Claims 1-3, 7-8, 10-14, 16, 18, 35-37, 41-47, 49, and 51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hodgson et al. (5,376,439).

Hodgson et al. teach narrow molecular weight polyethylene materials that have been formed into films comprising high density polyethylene cores (column 2, lines 45+). While Hodgson et al. do not specify state the they are using single site catalysts, this can be inferred by their reference to the new generation of polymers having narrow molecular weights, in which recited properties are attributes of polymers made by metallocene catalysis. Furthermore, Exxon has been a pioneer in the area of metallocene catalysis. Since the properties of the polymers of the polymers recited by Hodgson et al. are the same as those polymers produced by single site catalysis, the limitations of the claims which are directed to a formed article have been met since the end product would be indistinguishable.

Art Unit: 1773

Response to Arguments

5. Applicant's arguments filed 11-1-99 have been fully considered but they are not persuasive. The applicants state that Hodgson et al. (4,376,439) are not available as prior art since the applicants have an effective filing date of June 23, 1993; however, Hodgson et al. have an effective filing date of September, 16, 1992, since the patent in question is a continuation of 07/945,769 which was filed on that date. Lai et al. are also available as prior art since it has an effective filing date of October 15, 1991. The substance of the rejections under these patents have been maintained, but changed from 102(b) to 102(e) since the applicants have shown that they had continuity to the parent case 08/653,520.

The applicants state that LDPE can be produced by metallocene catalysis. The examiner continues to disagree. The examiner maintains that the term LLDPE and VLDPE have different structures from that of LDPE. LLDPE and VLDPE are linear materials where as LDPE is a highly branched species. These polymers have different properties and made by different routes of catalysis. The examiner points to Encyclopedia of Polymer Science's discussion of the structure of these two types of materials to support his position. The applicants points to "Enter a New Generation of Polyolefins" to support their position that single site catalysts can be used to produce LDPE (page 16, column 3) and that the term "LDPE" includes LLDPE and VLDPE. The passage in "Enter a New Generation of Polyolefins" is very brief and appears to go against the more extensive explanation in the Encyclopedia of Polymer Science. The examiner maintains that it continues to be unclear what is specifically meant by "Low Density Polyethylene" in the applicants claims 15 and 48 and how such

Art Unit: 1773

polymers are made by metallocene catalysis. The examiner maintains the position that LDPE materials have branching as shown by the Encyclopedia of Polymer Science, that materials produced by metallocene catalysis are linear in nature, and lack appreciable long chain branching and that these are not the same types of materials.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703) 308-2379. The examiner can normally be reached on M-F from 8:30 am to 5:30 pm.

Application/Control Number: 08/886,881


Page 6

Art Unit: 1773

The official fax number for the art unit is (703)-305-3599. The special fax number for amendments after final is (703)-305-5408. The number for unofficial faxes is (703)-305-5436.

D. Lawrence Tarazano
Patent Examiner

January 11, 2000



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700